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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,912	11/23/1999	GUNNER D. DANNEELS	042390.P7609	4438

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EXAMINER

EATON, KIMBERLY B

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,912

Applicant(s)

DANNEELS ET AL.

Examiner

Kimberly B Eaton

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 8-12, 14-17 and 20-23 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Laor. In re claim 1 Laor shows in figures 1-5 and related text a registration function to register a user as a club member (column 2, line 14 - column 2, line 21; column 4, line 5 – column 4, line 14); a credential creation function to create a value token associating a club member with a benefit provided by the at least one affiliate of a club manager (column 2, line 14 - column 2, line 21; column 3, line 14 – column 3, line 21); cryptographically signing the value token to create a credential (column 2, line 18 - column 2, line 21 ;column 2, line 41 – column 2, line 45); communicating the credential to the at least one affiliate for fulfillment of the benefit (column 2, line 13 - column 2, line 21; column 18; column 4, line 20 – column 4, line 29).

In re claim 2 Laor shows in figures 1-5 and related text a credential storage function to store information associating a club member with a value token and benefit (column 2, line 39 - column 2, line 45).

In re claim 3 Laor shows in figures 1-5 and related text at least one of the following; a membership number, a random number, a billing number, personal information about the user, a user-

selected password, time-stamp information (column 4, line 5 - column 4, line 14; column 5, line 54 - column 5, line 57).

In re claim 4 Laor shows in figures 1-5 and related text at least one of the following; a prize, a product discount, a service discount, free goods, free services, access to content, goods or services not available to the general public (column 2, line 53 - column 2, line 60).

In re claim 5 Laor shows in figures 1-5 and related text a web site (column 3, line 52 - column 3, line 56; column 5, line 62 - column 5, line 64).

In re claim 6 Laor shows in figures 1-5 and related text a credential verification function to receive a credential including a value token from a club manager (column 2, line 14 - column 2, line 21; column 2, line 53 - column 2, line 60); the value token associating a user with entitlement to a benefit as a club member (column 2, line 53 - column 60); verifying the authenticity of the credential (column 2, line 39 - column 2, line 45); a benefit provision to provide a benefit to a club member if the value token is valid (column 2, line 39 - column 2, line 45).

In re claim 8 Laor shows in figures 1-5 and related text at least one of the following; a prize, a product discount, a service discount, free goods, free services, access to content, goods, or services not available to the general public (column 2, line 53 - column 2, line 60).

In re claim 9 Laor shows in figures 1-5 and related text a web site (column 3, line 52 - column 3, line 56; column 3 line 62 - column 3, line 64).

In re claim 10 shows in figures 1-5 and related text a club manager to register a user as a club member (column 2, line 14 - column 2, line 21; column 4, line 5 - column 4, line 14); a value token associating a club member with entitlement to a benefit (column 2, line 14 - column 2, line 21; column 3, line 14 - column 3, line 21); cryptographically signing the value token to create a credential (column 2, line 18 - column 2, line 21; column 2, line 41 - column 2, line 45); verifying the authenticity of the value token of the credential (column 2, line 39 - column 2, line 45); providing the benefit to the club member if the value token is valid (column 2, line 39 - column 2, line 45).

In re claim 11 Laor shows in figures 1-5 and related text web sites (column 3, line 52 - column 3, line 56; column 3 line 62 – column 3, line 64); at least one server and a network for coupling a club manager to at least one affiliate (column 3, line 31 – column 3, line 49).

In re claim 12 Laor shows in figures 1-5 and related text registering the user as a member of a club (column 2, line 14 - column 2, line 21; column 4, line 5 - column 4, line 14); creating a value token associating the club member with entitlement to a benefit (column 3, line 13 – column 3, line 21); cryptographically signing the value token to create a credential (column 2, line 14 - column 2, line 21; column 3, line 14 – column 3, line 21); communicating the credential to the at least one affiliate (column 2, line 14 – column 2, line 18).

In re claim 14 Laor shows in figures 1-5 and related text at least one of the following; a membership number, a random number, a billing number, personal information about the user, a user-selected password, time stamp information (column 4, line 5 - column 4, line 14; column 5, line 54 – column 5, line 57).

In re claim 15 Laor shows in figures 1-5 and related text at least one of the following; a prize, a product discount, a service discount, free goods, free services, access to content, goods or services not available to the general public (column 2, line 53 - column 2, line 60).

In re claim 16 Laor shows in figures 1-5 and related text sending the credential to at least one affiliate as a link implemented in dynamic hyper-text markup language (column 5, line 32 – column 5, line 36).

In re claim 17 Laor shows in figures 1-5 and related text receiving a credential signed by a club manager, the credential including a value token associating a club member with entitlement to a benefit (column 2, line 14 - column 2, line 21; column 2, line 53 – column 2, line 60); verifying authenticity of the value token (column 2, line 16 - column 2, line 21); a club member requesting information from a server wherein it is inherent that in order to request information from the server the client must provide an indication to the server as to what information he desires which thus shows obtaining from the club member information to complete a benefit transaction (column 4, line 52 - column 4, line 53); providing the benefit to the club member when the value token is verified (column 2, line 39 - column 2, line 45).

In re claim 20 Laor shows in figures 1-5 and related text at least one of the following; a membership number, a random number, a billing number, personal information about the user, a user-selected password, time-stamp information (column 4, line 5 – column 4, line 14; column 5, line 54 – column 5, line 57).

In re claim 22 Laor shows in figures 1-5 and related text registering a member of a club (column 4, line 5 - column 4, line 14); indicating to a club manager a desire to receive a benefit from an affiliate (column 4, line 52 – column 4, line 55); communicating information to an affiliate to enable the affiliate to deliver the benefit (column 2, line 14 – column 2, line 18).

In re claim 23 Laor shows in figures 1-5 and related text websites (column 3, line 52 – column 3, line 56; column 5, line 62 – column 5, line 64); at least one of the following; a prize, a product discount, a service discount, free goods, free services, access to content, goods, or services not available to the general public (column 2, line 53 - column 2, line 60).

In re claim 24 Laor shows in figures 1-5 and related text an IBM PC compatible operating system where it is inherent that an IBM PC is an article comprising machine readable medium having a plurality of machine readable instructions, wherein the instructions are executed by a processor (column 3, line 50 – column 3, line 52); the instructions allow a user to obtain a benefit from at least one affiliate because the user is a member of a club in an electronic commerce system (column 2, line 14 – column 2 line 18); registering the user as a member of a club (column 2, line 14 - column 2, line 21; column 4, line 5 - column 4, line 14); creating a value token associating the club member with entitlement to a benefit (column 3, line 13 – column 3, line 21); cryptographically signing the value token to create a credential (column 2, line 14 - column 2, line 21; column 3, line 14 – column 3, line 21); communicating the credential to the at least one affiliate (column 2, line 14 – column 2, line 18).

In re claim 25 Laor shows in figures 1-5 and related text an IBM PC compatible operating system where it is inherent that an IBM PC is an article comprising machine readable medium having a plurality of machine readable instructions, wherein the instructions are executed by a processor (column 3, line 50 – column 3, line 520); the instructions coordinate provision of a benefit by an affiliate to a member of a club controlled by a club manager in a electronic commerce system (column 2, line 14 – column 2 line

18); receiving a credential signed by a club manager, the credential including a value token associating a club member with entitlement to a benefit (column 2, line 14 - column 2, line 21; column 2, line 53 - column 2, line 60); verifying authenticity of the value token (column 2, line 16 - column 2, line 21); a club member requesting information from a server wherein it is inherent that in order to request information from the server the client must provide an indication to the server as to what information he desires which thus shows obtaining from the club member information to complete a benefit transaction (column 4, line 52 - column 4, line 53); providing the benefit to the club member when the value token is verified (column 2, line 39 - column 2, line 45).

In re claim 26 Laor shows in figures 1-5 and related text an IBM PC compatible operating system where it is inherent that an IBM PC is an article comprising machine readable medium having a plurality of machine readable instructions, wherein the instructions are executed by a processor (column 3, line 50 - column 3, line 52); the instructions coordinate provision of a benefit by an affiliate to a member of a club controlled by a club manager in a electronic commerce system (column 2, line 14 - column 2 line 18); registering a member of a club (column 4, line 5 - column 4, line 14); indicating to a club manager a desire to receive a benefit from an affiliate (column 4, line 52 - column 4, line 55); communicating information to an affiliate to enable the affiliate to deliver the benefit (column 2, line 14 - column 2, line 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laor as applied to claim 6 above, and further in view of Eggleston et al. In re claim 7, Laor substantially discloses the invention as claimed, but fails to show a credential database to store credentials for completed transactions of provision of benefits. Eggleston et al shows in an analogous art related to a method of and system for distributing and redeeming electronic coupons in a computer network environment, in figures 1-26 and related text, an affiliate comprising a credential database to store credentials for completed transactions of provision of benefits (column 13, line 7 – column 13, line 28). Eggleston also teaches that companies offer discount programs to obtain customer information (column 1, line 41 – column 1, line 45). By incorporating a credential database affiliates would be able to track the success of the promotional programs they offer and customer buying patterns. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for an affiliate to store credentials for completed transactions of provision of benefits in a credential database in Laor as taught in Eggleston et al for the explicit reasons discussed herein above.

Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laor as applied to claim 12 above, and further in view of Scroggie et al. In re claim 13, Laor substantially discloses the invention as claimed, but fails to show using the value token previously created for a club member and benefit when the benefit has been obtained by the club member. Scroggie et al shows in an analogous art related to a method of and system for distributing and redeeming electronic coupons in a computer network environment, in figures 1-15 and related text, using the value token previously created for a club member and benefit when the benefit has been obtained by the club member (column 8, line 22 – column 8, line 24). By using a single value token for each benefit associated with a club member, a club manager can prevent duplicate redemptions of products and thus reduce costs incurred by offering the benefit. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention for an affiliate to store credentials for completed transactions of provision of benefits in a credential database in Laor as taught in Eggleston et al for the explicit reasons discussed herein above.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laor as applied to claim 17 above, and further in view of Barnett et al. In re claim 18, Laor substantially discloses the invention as claimed, but fails to show registering the value token as used after the benefit transaction is completed. Eggleston et al shows in an analogous art related to a method and system for electronic distribution of product redemption coupons, in figures 1-26 and related text, registering the value token as used after the benefit transaction is completed (column 5, line 46 – column 5, line 62). In certain instances an affiliate may want to offer a club member only one chance to redeem a value token in order that the club manager may reduce costs incurred by offering the benefit, thus it would be to the affiliate's advantage to register each token as used after the benefit transaction is completed. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to register the value token as used after the benefit transaction is completed in Laor as taught in Barnett et al for the explicit reasons discussed herein above.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laor as applied to claim 17 above, and further in view of Eggleston et al. In re claim 19, Laor substantially discloses the invention as claimed, but fails to show billing a club manager for a benefit provided to a club member. Eggleston et al shows in an analogous art related to a method of and system for distributing and redeeming electronic coupons in a computer network environment, in figures 1-26 and related text, billing a club manager for a benefit provided to a club member (column 15, line 8 – column 15, line 12). Billing a club manager for a benefit provided allows a club manager to offer an incentive to a club member without financially burdening the affiliate offering the benefit redemption. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to bill a club manager for a benefit provided to a club member in Laor as taught in Eggleston et al for the explicit reasons discussed herein above.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laor as applied to claim 17 above, and further in view of Barnett et al. In re claim 21, Laor substantially discloses the invention as claimed, but fails to show verifying the authenticity further comprises determining that the value token has not been previously used. Barnett et al shows in an analogous art related to a method and system for electronic distribution of product redemption coupons, in figures 1-10 and related text, verifying the

authenticity comprises determining that the value token has not been previously used (column 5, line 46 – column 5, line 62). By determining a value token has not previously been used a club manager or affiliate can reduce fraud and offer one-time use value tokens. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to verify the authenticity by determining that the value token has not been previously used in Laor as taught in Barnett et al for the explicit reasons discussed herein above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly B Eaton whose telephone number is 703-305-3229. The examiner can normally be reached Monday through Friday from 8:00 am – 6:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768.


The Fax phone number for the UNOFFICIAL FAX for the organization where this application or proceeding is assigned is (703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the OFFICIAL FAX for the organization where this application or proceeding is assigned is (703) 746-7239 (for formal communications intended for entry).

The Fax phone number for AFTER-FINAL communications where this application or proceeding is assigned in (703) 746-7238.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

December 11, 2001


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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